

Remarks

A. Claims In The Case

Claims 1 – 19 are rejected. Claim 17 has been amended. Claims 1 – 19 are pending in the case.

B. 35 U.S.C. §103 Rejections

The Examiner rejected claims 1, 3, 6, 8-10, 12, 15, and 17-19 under 35 U.S.C. 103(a) as being unpatentable over Lai (U.S. Patent No. 6,323,841) (hereinafter “Lai”) in view of Wolden (U.S. Patent No. 5,599,280) (hereinafter “Wolden”). Applicant respectfully disagrees with the rejections.

In order to reject a claim as obvious, the Examiner has the burden of establishing a *prima facie* case of obviousness. *In re Warner et al.*, 379 F.2d 1011, 154 U.S.P.Q. 173, 177-178 (C.C.P.A. 1967). To establish a *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. (emphasis added) *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974), MPEP § 2143.03.

Neither Lai nor Wolden disclose, teach, or suggest, either separately or in combination “A computer mouse or trackball comprising: a heating element” as recited in claim 1. Neither of the references discloses a mouse or trackball that comprises a heating element. In addition, neither of the references discloses an input device comprising a heating element. Lai does not disclose a heating element, and Wolden only discloses a heating pad external to a keyboard.

Furthermore, neither Lai nor Wolden disclose, teach, or suggest, either separately or in combination “the input device is configured to transfer heat from the heating element to the hand

or wrist of a user of the input device during use (emphasis added)” as recited in claim 1. As stated above, neither Lai nor Wolden disclose a heating element in an input device. It therefore follows that neither of the references teaches or suggests an input device transferring heat to a user’s hand or wrist during use. Applicant respectfully asserts claim 1 and claims dependent thereon are allowable for at least the above reasons.

In addition, neither Lai nor Wolden disclose, teach, or suggest, either separately or in combination “the input device is configured to transfer vibrations from the vibrating element to the hand or wrist of a user of the input device during use” as recited in claim 10. Wolden does not disclose using a vibrating element in an input device, and Lai teaches away from using a vibrating element in an input device during use. For example, Lai teaches “when the rear part (20) is connected with the front part (10) to form a whole mouse, the massaging head (21) is only a resilient soft pad and will not vibrate to affect the operation of the mouse. (emphasis added) (Lai, col. 3, lines 45-48).” As stated in MPEP §2141.02: “A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984).” Applicant respectfully asserts claim 10 and claims dependent on claim 10 are allowable for at least the above reasons.

For similar reasons as discussed above with respect to claims 1 and 10, Lai and Wolden do not disclose, teach, or suggest, either separately or in combination “the input device is configured to transfer heat from the heating element to the hand or wrist of a user of the input device during use” and “the input device is configured to transfer vibrations from the vibrating element to the hand or wrist of a user of the input device during use” as recited in claim 19. Applicant respectfully asserts claim 19 is allowable for at least the above reasons.

In addition, the Office Action has not stated a *prima facie* case of obviousness for combining Lai and Wolden. As stated in the MPEP §2142:

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). (emphasis added)

There is no teaching or suggestion to combine Lai and Wolden either in the references or in the prior art. Applicant respectfully asserts claims 1, 10, 19 and claims dependent thereon are also allowable for at least the above reasons.

In addition, neither Lai nor Wolden disclose, teach, or suggest, either separately or in combination "power to the heating element is supplied by the computer system" as recited in claim 6. The Examiner states:

However, Lai does not teach wherein power to the heating element is supplied by the computer. Wolden discloses wherein the power to the heating element is supplied by the computer input device (see column 2, lines 40-44).

Applicant notes Wolden, at column 2, lines 40-44 states:

FIG. 4 shows a control unit 20 and electrical cord 21 of the invention. Control unit 20 comprises switches for controlling the electrical power to the heating elements and vibrating devices. (Wolden, col. 2, lines 40-44).

Wolden does not disclose that the electrical cord 21 comes from the computer system. Applicant respectfully asserts claim 6 is also allowable for at least the above reasons.

Lai and Wolden do not disclose, teach, or suggest, either separately or in combination “the microcontroller is configured to control the amount of vibration produced by the vibrating element” as recited in claim 12. The Examiner points to Lai at column 3, lines 22-29 for this teaching. However, Lai teaches a massaging head that is either on or off. Lai does not appear to disclose a microcontroller to control the amount of vibration. Applicant respectfully asserts claim 12 is also allowable for at least the above reasons.

The Examiner rejected claims 2 and 4-5 under 35 U.S.C. 103(a) as being unpatentable over Lai in view of Wolden in view of Tu et al. (U.S. Patent No. 6,206,842) (hereinafter “Tu”). Applicant respectfully disagrees with the rejections.

Applicant respectfully asserts the Office Action has not stated a prima facie case of obviousness for combining Lai, Wolden, and Tu. As stated in the MPEP §2142:

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant’s disclosure. In re Vaack, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). (emphasis added)

There is no teaching or suggestion to combine Lai, Wolden, and Tu either in the references or in the prior art. For example, Lai is directed to a computer mouse while Tu is directed toward a device for treating hemorrhoids. Applicant respectfully submits that the Examiner appears to be combining the references in a piecemeal fashion. As held by the U.S. Court of Appeals for the Federal Circuit in *Ecolchem Inc. v. Southern California Edison Co.*, an obviousness claim that

lacks evidence of a suggestion or motivation for one of skill in the art to combine prior art references to produce the claimed invention is defective as hindsight analysis.

In addition, the showing of a suggestion, teaching, or motivation to combine prior teachings “must be clear and particular Broad conclusory statements regarding the teaching of multiple references, standing alone, are not ‘evidence’.” *In re Dembiczak*, 175 F.3d 994, 50 USPQ2d 1614 (Fed. Cir. 1999). The art must fairly teach or suggest to one to make the specific combination as claimed. That one achieves an improved result by making such a combination is no more than hindsight without an initial suggestion to make the combination. There is no motivation either in the references or in the prior art to combine the teachings of Lai, Wolden, and Tu. Applicant respectfully asserts claims 2 and 4-5 are allowable for at least the above reasons.

The Examiner rejected claims 11 and 13-14 under 35 U.S.C. 103(a) as being unpatentable over Lai in view of Wolden in view of Moriyasu (U.S. Patent No. 5,857,986) (hereinafter “Moriyasu”). Applicant respectfully disagrees with the rejections.

Lai, Wolden, and Moriyasu do not disclose, teach, or suggest, either separately or in combination, “a vibration sensor coupled to the vibrating element” as recited in claim 11. The Examiner points to Moriyasu for this teaching. However, Moriyasu discloses “a detector to detect electronic signals sent between a computer and an input/output device (Moriyasu, col. 2, lines 1-3).” Lai, Wolden, and Moriyasu do not disclose a “vibration sensor.” In addition, the cited references do not disclose “the microcontroller is configured to control the vibrations produced by the vibrating element in response to the vibrations monitored by the vibration sensor (emphasis added)” as recited in claim 13 or “the computer system is configured to control the amount of vibration produced by the vibrating element in response to vibrations monitored by the vibrating sensor (emphasis added)” as recited in claim 14. Applicant respectfully asserts claims 11, 13, and 14 are allowable for at least the above reasons.

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Appl. Ser. No.: 09/874,426
Att. Dckt. No.: 5181-76500

The Examiner rejected claims 7 and 16 under 35 U.S.C. 103(a) as being unpatentable over Lai in view of Wolden in view of Wright, Sr. (U.S. Patent No. 5,686,005) (hereinafter "Wright"). Applicant respectfully disagrees with the rejections. Applicant respectfully asserts claims 7 and 16, dependent on patentably distinct claims 1 and 10, respectively, are allowable for at least the above reasons.

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C. Additional Remarks

Based on the above, Applicant submits that all claims are in condition for allowance.
Favorable reconsideration is respectfully solicited.

Applicant believes no fee is required with this response. Should any fees be required or if any fees have been overpaid, please appropriately charge or credit those fees to Meyertons, Hood, Kivlin, Kowert & Goetzel, P.C. Deposit Account Number 50-1505/5181-76500/BNK.

Respectfully submitted,



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